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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|-----------------------|------------------|
| 10/784,149 | 02/20/2004 | Andreas Richter | 081583-0294 | 5352 |
| 23409 | 7590 | 11/21/2005 | EXAMINER | |
| MICHAEL BEST & FRIEDRICH, LLP 100 E WISCONSIN AVENUE MILWAUKEE, WI 53202 | | | YAMNITZKY, MARIE ROSE | |
| | | | ART UNIT | PAPER NUMBER |

1774

DATE MAILED: 11/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/784,149

Applicant(s)

RICHTER ET AL.

Examiner

Marie R. Yamnitzky

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-4, 8, 9, 17-22 and 24-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 2, 3, 8, 9, 17-22 and 24-29 is/are allowed.
- 6) ☒ Claim(s) 4 and 30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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1. This Office action is in response to applicant's amendment received September 09, 2005, which amends the specification and claims 2-4, 8, 17-22 and 24, cancels claims 1, 5-7, 14-16 and 23, and adds claims 25-30.

Claims 2-4, 8, 9, 17-22 and 24-30 are pending.

2. The rejection of claim 2 under 35 U.S.C. 112, 2nd paragraph, as set forth in the Office action mailed June 03, 2005, is overcome by applicant's amendment.

The rejection under 35 U.S.C. 102(b) based on JP 10-284250 is rendered moot in part by claim cancellation, and otherwise overcome by claim amendment.

The rejection under 35 U.S.C. 103(a) based on Mori et al. (US 5,281,489) in view of Butterfield (US 3,671,451) is rendered moot in part by claim cancellation, and otherwise overcome by claim amendment.

3. The oath or declaration is defective for the reasons noted in the Office action mailed June 03, 2005. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

4. As noted in the Office action mailed June 03, 2005, applicant has claimed foreign priority based on an application filed in Germany on August 21, 2001, but applicant has not filed a certified copy of the application as required by 35 U.S.C. 119(b).

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5. The remarks accompanying applicant's amendment received September 09, 2005 indicate that a new declaration and a certified copy of German Application No. 10141266.5 "will be filed shortly". To the examiner's knowledge, the declaration and priority application have not yet been filed as they are currently not present in the IFW. On October 17, 2005, the examiner telephonically notified applicant's representative, Gregory Hartwig, that the declaration and priority application should be filed by the end of October so as to help ensure that they would be in the IFW prior to the examiner acting on the case in November.

6. Claims 4 and 30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In formula 1 in claim 4, R^2 and R^3 are not depicted as forming a ring, and R^6 and R^7 are not depicted as forming a ring. No definition for R^2 , R^3 , R^6 and R^7 is set forth in claim 4. It is not clear if R^2 , R^3 , R^6 and R^7 are to be interpreted as having the same definition as set forth in claim 8, from which claim 4 depends, or if claim 4 improperly fails to further limit the subject matter of the claim from which it depends. (If, in response to this action, applicant redraws the formula in claim 4 to depict the ring formation depicted in formula 20a in claim 8, the examiner suggests deleting the formula number in claim 4 since the formula will not be the same as formula 1 as set forth in the specification.)

Claim 30 recites that R^4 and R^8 "can be" certain specified fluorinated phenyl groups. It is not clear if R^4 and R^8 can be something other than the specified fluorinated phenyl groups,

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selected from the broader possibilities set forth in claim 8, from which claim 30 depends. If not, the examiner suggests changing "can be" to --are-- (or to --are the same or different and are--).

7. Claims 2, 3, 8, 9, 17-22 and 24-29 are allowed.

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any inquiry concerning this communication should be directed to Marie R. Yamnitzky at telephone number (571) 272-1531. The examiner works a flexible schedule but can generally be reached at this number from 6:30 a.m. to 4:00 p.m. Monday, Tuesday, Thursday and Friday, and every other Wednesday from 6:30 a.m. to 3:00 p.m.

The current fax number for all official faxes is (571) 273-8300. (Unofficial faxes to be sent directly to examiner Yamnitzky can be sent to (571) 273-1531.)

MRY
November 15, 2005



MARIE YAMNITZKY
PRIMARY EXAMINER

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